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REMARKS

The Examiner has rejected Claims 4, 16, 21 and 23 under 35 U.S.C. 112, second paragraph, as being indefinite. Applicant respectfully disagrees. Specifically, the Examiner has referred to page 11, lines 1-3 of the instant application in supporting an argument that such excerpt contradicts applicant's claimed "wherein comparing a checksum comprises comparing checksums starting with one of the portions at the end of the remaining data and working backwards through the data" (see this or similar language in each of the foregoing claims).

Applicant notes that such excerpt from the application relates to generating a single checksum for the entire remaining portion of the email after the non-static material is removed. Applicant's claim language in the above claims, however, relates to the further portioning of the remaining portion of the email. It is such further portions that are compared from the end of the remaining data in a backwards fashion. For specific clarification, see page 11, line 15 - page 12, line 6.

The Examiner has rejected Claims 1-5 and 8-25 under 35 U.S.C. 103(a) as being unpatentable over Townshend (U.S. Patent No. 6,829,635) in view of Ralston et al., (U.S. Patent No. 6,842,773). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove to each of the independent claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d

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1438 (Fed.Cir.1991). Applicant respectfully asserts that at least the first and third element of the *prima facie* case of obviousness have not been met.

With respect to the first element of the *prima facie* case of obviousness, the Examiner argues that it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Townsend and Ralston as both inventions relate to ways of detecting and blocking bulk email. Applicant respectfully disagrees with this assertion, especially in view of the vast evidence to the contrary.

For example, Townshend *teaches away* from applicant's claim language. Specifically, it is noted that Townshend only suggests the selective *inclusion* of certain elements, not the removal of non-static data, so that the remaining data may be used in the generation of the checksum. Further, Townshend makes absolutely no mention of removing end-of line characters and headers, as claimed. In fact, Townshend specifically discloses creating a hash for each of the different electronic message parts, including the header, so that bulk mail may be better identified. Thus, Townshend *teaches away* from any sort of removal of headers and, in view of such, applicant respectfully asserts that the first element of the *prima facie* case of obviousness has not been met. *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986).

With respect to the third element of the *prima facie* case of obvious, applicant respectfully asserts that the prior art references fail to teach or suggest all of applicant's claim limitations. Specifically, with respect to each of the independent claims, the Examiner has failed to even address applicant's claimed technique "wherein the non-static data is removed to prevent the non-static data from being subject to the checksum, so that non-static data does not compromise the identification of the electronic message as the unsolicited message." Applicant asserts that neither Townshend nor Ralston teach such specific claim language. Thus, the third element of the *prima facie* case of obviousness has not been met since the prior art references fails to teach or suggest all the claim limitations.

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Nevertheless, despite the foregoing paramount distinctions and in the spirit of expediting the prosecution of the present application, applicant has clarified each of the independent claims to further distinguish the prior art of record. Specifically, applicant has amended each of the independent claims to read, at least in part:

"removing non-static data including <u>visible</u> end-of-line characters and headers, from the electronic mail message"; and

"wherein the non-static data is removed to prevent the non-static data from being subject to the checksum, so that non-static data <u>forged by spammers</u> does not compromise the identification of the electronic message as the unsolicited message."

Applicant respectfully asserts that removing <u>visible</u> end-of-line characters and headers, as presently claimed by applicant, clearly distinguishes the Ralston reference. In particular, Ralston expressly discloses only removing <u>hidden information</u> to leave behind only the visible body of the message. Thus, Ralston does not meet applicant's removal of visible end-of-line characters and headers.

A notice of allowance or a specific prior art showing of each of the foregoing limitations, in combination with the remaining claim elements, is respectfully requested.

It is further noted that the Examiner's rejection of applicant's dependent claims is replete with deficiencies. Just by way of example, the Examiner has admitted that Townshend fails to explicitly disclose applicant's claimed technique "wherein comparing a checksum comprises comparing checksums starting with one of the portions at the end of the remaining data and working backwards through the data" (see Claim 4 et al.). The Examiner continues by arguing that "it is notoriously well known in the art to make comparisons between items in any order [and that t]herefore it would have been obvious to one of ordinary skill in the art at the time of the invention to compare checksums in either direction (top to bottom, or bottom to top) providing the benefit of identifying unsolicited emails."

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Applicant respectfully disagrees with this assertion. Simply because it is allegedly well known to make comparisons between items in any order, as the Examiner contends, such does not make applicant's specific claim language obvious. Applicant does not merely claim comparing items in any order, but claims, in the relevant claim(s), comparing checksums for each portion of remaining data starting at the end of the remaining data and working backwards through the data. Thus, each portion of remaining data has an associated checksum which is compared starting at the end of the remaining data, working through to the beginning of the remaining data. Thus, such feature would not be obvious in view of the claimed context of such comparing and in view of the advantages thereof, namely in order to reduce required processing.

Again, applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art reference fails to teach or suggest all the claim limitations. A notice of allowance or a specific prior art showing of each of the foregoing limitations, in combination with the remaining claim elements, is respectfully requested.

With respect to dependent Claims 24 and 25, the Examiner has simply dismissed the same as being reflective of Claim 1. Applicant respectfully asserts that Claims 24 and 25 do not include the same limitations as in Claim 1. Therefore, a notice of allowance or a specific prior art showing of each of the foregoing limitations, in combination with the remaining claim elements, is respectfully requested.

To this end, all of the pending independent claims are deemed allowable, along with any dependent claims depending therefrom.

Reconsideration is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. Applicants are

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enclosing a check to pay for the added claims. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAIlP315/01.180.01).

Respectfully submitted,
Zilka-Kotab, PC

Kevin J. Zilka
Registration No. 41,429

P.O. Box 721120
San Jose, CA 95172-1120
408-505-5100